

REMARKS

I. Summary of the Office Action

Claims 1-109 are pending in this application.

Claims 1-6, 8, 10, 11, 13-16, 18, 19, 23, 24, 26-33, 35, 37, 38, 42-44, 48, 49, 53, 54, 56, 57, 60, 62-64, 66-69, 71, 74, 77, 78, 80, 81, 86, 89-91, 93-96, 99, 100, 103, 106, 107, and 109 were rejected under 35 U.S.C. § 103(a) as being obvious from Inoue et al. U.S. Patent No. 5,884,141 ("Inoue") in view of Lortz U.S. Patent No. 6,349,410 ("Lortz").

Claims 7, 9, 34, 36, 65, and 92 were rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Lortz, and in further view of Ismail et al. U.S. Patent No. 6,614,987 ("Ismail").

Claims 12, 17, 39, 45-47, 58, 59, 61, 70, 82-85, 87, 88, 97, and 98 were rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Lortz, and in further view of Baker et al U.S. Patent No. 5,583,561 ("Baker").

Claims 20, 21, 50, 51, 75, and 104 were rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Lortz, and in further view of Banker et al. U.S. Patent No. 5,357,276 ("Banker").

Claims 22, 25, 52, 55, 72-73, 76, 79, 101, 102, 105, and 108 were rejected under 35 U.S.C. § 103(a) as being

obvious from Inoue in view of Lortz, and in further view of White et al. U.S. Patent No. 6,392,664 ("White").

II. Summary of Applicants' Reply

Applicants have amended independent claims 1, 27, 57, and 81 to more particularly define the invention. No new matter has been added and the amendments are fully supported by the originally filed specification.

The Examiner's rejections are respectfully traversed.

III. Summary of the Interview

The Examiner and the undersigned conducted a telephonic interview on January 31, 2007. The undersigned wishes to thank the Examiner for the courtesies extended during the interview.

The Examiner and the undersigned discussed the amendments shown in this paper, and the Examiner stated that, pending further consideration, the amended claims are patentable over the prior art of record.

IV. Applicants' Reply to the Rejections of Independent Claims 1 and 27

Applicants' amended independent claims 1 and 27 are directed toward a system and method for allowing a user to

pause media at any time while the media is playing, and substituting pause-time content from a pause-time content database whenever the media is paused.

The Examiner rejected these claims as being obvious from Inoue in view of Lortz. In particular, the Examiner contends that Inoue shows all of the elements of applicants' claimed invention except for a pause-time content database. The Examiner attempts to make up for this deficiency by incorporating the web capabilities of Lortz. However, applicants respectfully submit that the combination of Inoue and Lortz is both insufficient and improper as a matter of law.

A. THE COMBINATION OF INOUE AND LORTZ DOES NOT SHOW ALL THE ELEMENTS OF APPLICANTS' CLAIMED INVENTION

Lortz describes a system for coordinating a regular television broadcast with web content. A viewer may pause a current broadcast and view web content corresponding to the broadcast by pressing a forward button. However, "if there is no currently valid URL associated with the broadcast, the set top device may not respond to a forward button selection" (col. 4, lines 28-30). Thus, Lortz does not show or suggest that a valid URL, and therefore corresponding web content, is always available, nor does Lortz show or suggest that a

broadcast may be paused at any time. Furthermore, since Lortz does not describe an alternative system response to a forward button selection when there is no valid URL, Lortz also does not show or suggest that the broadcast may be paused and/or web content may be retrieved without a valid URL.

For at least the foregoing reasons, Lortz does not teach or suggest "providing a user with the ability to pause the media at any time while the media is playing," as specified by applicants' amended claim 1 (emphasis added). In addition, even if the television broadcast could be paused at any time, which it could not, the Lortz system would be incapable of displaying web content "whenever the media is paused" (claim 1), since a valid URL may not be available at the time of the pause.

On page 4 of the Office Action, the Examiner attempts to combine Inoue and Lortz by "modify[ing] the broadcasted media programs, as taught by Inoue, using the embedded URLs displayed when a TV broadcast program is paused, as taught by Lortz." Therefore, the Examiner relies solely on the method described by Lortz for obtaining "pause-time content from a pause-time content database," as specified by applicants' claim 1. Thus, applicants respectfully submit that the combined system is incapable of

both (1) "providing a user with the ability to pause the media at any time while the media is paused," and (2) "playing the automatically retrieved pause-time content whenever the media is paused" (claim 1; emphasis added).

Accordingly, for at least the reason that the combination of Inoue and Lortz fails to teach or suggest all of the elements of applicants' claims 1 and 27, the rejection of independent claims 1 and 27 should be withdrawn.

B. THE EXAMINER HAS FAILED TO PROVIDE PROPER
MOTIVATION TO COMBINE THE REFERENCES

Instead of providing an objective teaching of a motivation to use the web content of Lortz with the system of Inoue, the Examiner concludes

it would have been obvious to a person of ordinary skill in the art, to modify the broadcasted media programs, as taught by Inoue, using the embedded URLs displayed when a TV broadcast program is paused, as taught by Lortz, for the purpose of coordinating the display of an incoming signal stream on a display with web browsing (Office Action, p. 4, lines 3-7).

This does not point to any objective teaching that would lead one of ordinary skill in the art to modify Inoue. Applicants respectfully submit that the Examiner has not provided an objective teaching in Inoue nor Lortz, nor to knowledge generally available to one of ordinary skill in the art, that

would lead an individual to modify Inoue to incorporate the web content of Lortz.

Applicants respectfully submit that, for the purpose of "coordinating the display of an incoming signal stream on a display with web browsing," one of ordinary skill in the art would not find it desirable to combine the web capabilities of Lortz with the NVOD system of Inoue. The combined system would necessitate embedding URLs in several (e.g., seven) channels. Furthermore, the combined system would need to determine which of the several channels to tune to and record from. Thus, the complexity of the combined system would be considerably greater than Lortz, which by itself describes a method for "coordinating the display of an incoming signal stream on a display with web browsing." Due to the added complexity, one of ordinary skill in the art would not be motivated to combine Inoue and Lortz.

In addition, applicants respectfully submit that Inoue and Lortz solve problems that are entirely different from that addressed by applicants' claims 1 and 27, and therefore would not teach one skilled in the art approaches for providing pause-time content. Inoue describes a method for providing a pause function in an NVOD system. Although a "pause graphics screen may be generated ... and displayed" during the pause (col. 6, lines 32-33), Inoue does not show

or suggest that pause-time content is automatically retrieved from a database and played, as admitted by the Examiner.

In contrast, Lortz provides a method for viewers to switch between two different types of content, a television broadcast and web content. A viewer purposely presses a button to access web content, if available, not to pause the broadcast. Thus, the pausing in Lortz is merely a derivative action that may occur when the user switches from a broadcast to web content.

Applicants' approach provides enticing and relevant pause-time content to the user (whenever media is paused) when the user does not otherwise expect content. Thus, the only way one skilled in the art would be motivated to combine the contrasting teachings of Inoue, which provides uninspired content in response to a pause command, and Lortz, which enables a user to view web content if such content is available, to arrive at applicants' claimed approach of playing content automatically retrieved from a database whenever the media is paused is to use applicants' specification as a roadmap for making such a combination. Such use of applicants' specification is in essence hindsight reconstruction and impermissible as a matter of law.

Thus, because one of ordinary skill in the art would not be motivated to combine Inoue and Lortz for the

purpose of "coordinating the display of an incoming signal stream on a display with web browsing," as stated by the Examiner in the Office Action, the Examiner has not provided an objective teaching that would lead one to combine these references.

For at least these reasons, applicants respectfully submit that the combination of Inoue and Lortz is improper. Applicants respectfully request that the rejections to independent claims 57 and 81 be withdrawn.

V. Applicants' Reply to the Rejections of Independent Claims 57 and 81

Applicants' amended independent claims 57 and 81 are directed toward a system and method for allowing a user to pause media at any time while the media is playing, and substituting pause-time content whenever the media is paused, where the subject matter of the pause-time content is related to the subject matter of the paused media.

The Examiner contends that Inoue shows all of the elements of applicants' claimed invention except for the limitation that the pause-time content is related to the paused media. The Examiner attempts to make up for the deficiency by incorporating Lortz's web content. Therefore, the Examiner relies solely on the method described by Lortz for obtaining pause-time content, "wherein the subject matter

of the pause-time content is related to the subject matter of the paused media," as specified by applicants' claim 57. For at least the reasons set forth above in Section IV(A), applicants respectfully submit that the combined system is incapable of both (1) "providing a user with the ability to pause the media at any time while the media is paused," and (2) "playing the automatically retrieved pause-time content whenever the media is paused" (claim 57; emphasis added).

Furthermore, applicants respectfully submit that combining Inoue and Lortz for the purpose of "coordinating the display of an incoming signal stream on a display with web browsing," as stated by the Examiner, is not proper motivation for one of ordinary skill in the art to combine the two references. Moreover, there is no objective teaching found in either reference, or from the knowledge of one of ordinary skill in the art, to combine Inoue and Lortz.

As admitted by the Examiner, although Inoue may display content during a pause, Inoue does not show or suggest that "the subject matter of the pause-time content is related to the subject matter of the paused media" (claim 57). In fact, Inoue does not show or suggest that there is any purpose to providing content during a pause, insofar as to allow the current broadcast to continue playing during the pause (col. 6, lines 30-31).

Lortz, on the other hand, allows a viewer to switch between a broadcast and an associated web page (when available). Thus, a viewer purposely presses a button to access associated web content, if available, not to pause the broadcast. Therefore, the pausing in Lortz is merely a derivative action that may occur when the user switches from a broadcast to web content.

Thus, but for applicant's own specification, which provides significant pause-time content when one would not ordinarily expect it, one of ordinary skill in the art would not be motivated to combine these two completely unrelated references. Therefore, the combination of Inoue and Lortz could only have been made using hindsight construction, which is improper as a matter of law. Accordingly, applicants respectfully request that the rejection to independent claims 57 and 81 be withdrawn.

VI. Applicants' Reply to the Rejections of
the Dependent Claims

Claims 2-6, 8, 10, 11, 13-16, 18, 19, 23, 24, 26, 28-33, 35, 37, 38, 42-44, 48, 49, 53, 54, 56, 60, 62-64, 66-69, 71, 74, 77, 78, 80, 86, 89-91, 93-96, 99, 100, 103, 106, 107, and 109 were rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Lortz.

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Claims 20, 21, 50, 51, 75, and 104 were rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Lortz, and in further view of Banker.

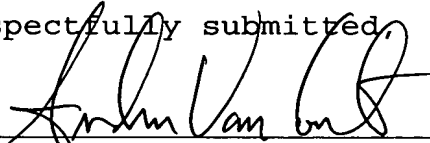
Claims 22, 25, 52, 55, 72-73, 76, 79, 101, 102, 105, and 108 were rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Lortz, and in further view of White.

Applicants have shown above in Sections IV and V of this Reply that independent claims 1, 27, 57, and 81 are allowable. The claims listed above, which depend variously from independent claims 1, 27, 57, or 81, are allowable at least because they depend from allowable claims. The rejection of these claims should therefore be withdrawn.

VII. Conclusion

In view of the foregoing, claims 1-109 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



Andrew Van Court
Registration No. 48,506
Agent for Applicants
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
Customer No. 1473
1211 Avenue of the Americas
New York, New York 10036-8704
Tel.: (212) 596-9000
Fax: (212) 596-9090